

## **REMARKS**

In view of the above amendments and the following remarks, reconsideration and further examination are respectfully requested.

### **I. Priority Issues**

Acknowledgement has been made of the Applicants' claim for foreign priority. However, the Outstanding Office action indicates that the Applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C § 119(b).

Initially, please note that the present application is a national stage application of PCT/JP2002/017071, filed November 17, 2004. The Applicants claim priority to Japanese Patent Application No. 2003-389563, filed November 19, 2003, as acknowledged in the Declaration of this application.

The Applicant submitted a copy of Form PCT/IB/304 with the present application on May 19, 2006 to demonstrate that a certified copy of the foreign priority document was received by the International Bureau.

Accordingly, the Applicant has made a proper claim of foreign priority, and the Office should have received a certified copy of the foreign priority document, in compliance with PCT Rule 17.2(a).

Therefore, the Applicant respectfully requests that the Examiner acknowledge the Applicant's claim of foreign priority and confirm receipt of the certified copy of the foreign priority document.

## **II. Amendments to the Specification and Abstract**

The specification and abstract have been reviewed and revised to improve their English grammar. The amendments to the specification and abstract have been incorporated into a substitute specification and abstract. Attached are two versions of the substitute specification and abstract, a marked-up version showing the revisions, as well as a clean version. No new matter has been added.

## **III. Amendments to the Claims**

Withdrawn claims 1-5 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

Further, claims 6-13 have been amended to clarify features of the invention recited therein and to further distinguish the present invention from the references relied upon in the rejections discussed below. In addition, new claim 14 has been added to depend from claim 8.

It is also noted that claims 6-13 have been amended to make a number of editorial revisions thereto. These editorial revisions have been made to place the claims in better U.S. form. Further, these editorial revisions have not been made to narrow the scope of protection of the claims, or to address issues related to patentability, and therefore, these amendments should not be construed as limiting the scope of equivalents of the claimed features offered by the Doctrine of Equivalents.

#### **IV. 35 U.S.C. §101 Rejection**

Claims 8-13 were rejected under 35 U.S.C. § 101 for failure to recite statutory subject matter. Specifically, claims 8-13 were rejected for reciting limitations (e.g., a “license management section”) which could be interpreted as software alone, which is not statutory subject matter. Claims 8-13 have been amended to clarify that the claimed invention is not software, by replacing the term “section” with the term “unit,” and by adding a “contents storage unit,” which requires more than just software alone (e.g., memory). As a result, because each of amended claims 8-13 recites patentable subject matter, it is submitted that the Examiner’s rejection under 35 U.S.C. § 101 is inapplicable to claims 8-13.

#### **V. 35 U.S.C. § 112, Second Paragraph Rejections**

Claims 6-13 were rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that claims 6-13 recite terms that are indefinite for lack of proper antecedent basis. This rejection is believed clearly inapplicable to amended claims 6-13 since claims 6-13 have been amended to specifically avoid the problems identified by the Examiner and to otherwise comply with the requirements of 35 U.S.C. § 112, second paragraph. As a result, withdrawal of this rejection is respectfully requested.

## **VI. 35 U.S.C. § 103(a) Rejections**

Claims 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Clisham et al. (U.S. 2004/0168052) and Vilcauskas et al. (U.S. 2002/0152874). Further, claim 10, 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Clisham, Vilcauskas and Gould et al. (U.S. 6,393,158). Finally, claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Clisham, Vilcauskas, Gould and the Examiner's Official Notice. These rejections are believed clearly inapplicable to amended claims 6-13 and new claim 14 for the following reasons.

Independent claim 6 recites a method of reproducing content data, wherein the method includes a step of (i) prohibiting, during the reproduction of the one main resource, a start of reproducing a resource that is different from the one main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during said reproduction of the one sub resource, a start of reproducing a resource that is different from the one sub resource being reproduced and that requires the license information for reproduction thereof. Clisham and Vilcauskas, or any combination thereof, fails to disclose or suggest the above-mentioned distinguishing features as recited in amended independent claim 6.

Rather, Clisham is drawn to an electronic content communication system for providing content files from a server to a user (see Abstract). However, Clisham fails to disclose or suggest (i) prohibiting, during the reproduction of the one main resource, a start of reproducing a resource that is different from the one main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during said reproduction of the

one sub resource, a start of reproducing a resource that is different from the one sub resource being reproduced and that requires the license information for reproduction thereof, as required by claim 6.

Vilcauskas was relied upon for teaching the features of the claimed invention that were admittedly lacking from Clisham. However, Vilcauskas merely teaches an audio ownership system that determines whether a sufficient number of copies or licenses of a song are owned by the provider 34 to permit another download of the song (see Abstract and paragraph [0024]). Thus, in view of the above, it is clear that Vilcauskas fails to disclose or suggest (i) prohibiting, during the reproduction of the one main resource, a start of reproducing a resource that is different from the one main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during said reproduction of the one sub resource, a start of reproducing a resource that is different from the one sub resource being reproduced and that requires the license information for reproduction thereof, as recited in claim 6.

Therefore, because of the above-mentioned distinctions it is believed clear that claim 6 and claim 7 that depends therefrom would not have been obvious or result from any combination of Clisham and Vilcauskas.

Amended independent claim 8 is directed to a device and recites features that correspond to the above-mentioned distinguishing features of independent claim 6. Thus, for the same reasons discussed above, it is respectfully submitted that independent claim 8 and claims 9-14 that depend therefrom are allowable over any combination of Clisham and Vilcauskas.

Furthermore, there is no disclosure or suggestion in Clisham and/or Vilcauskas or elsewhere in the prior art of record which would have caused a person of ordinary skill in the art

to modify Clisham and/or Vilcauskas to obtain the invention of independent claims 6 and 8 and claims 7 and 9-14 that depend therefrom. Accordingly, it is respectfully submitted that independent claims 6 and 8 and claims 7 and 9-14 that depend therefrom are clearly allowable over the prior art of record.

Regarding dependent claims 10-13, which were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clisham and Vilcauskas in view of various combinations of Gould and Official Notice (secondary references), it is respectfully submitted that these secondary references do not disclose or suggest the above-discussed features of independent claims 6 and 8 which are lacking from Clisham and Vilcauskas. Therefore, no obvious combination of Clisham and Vilcauskas with any of the secondary references would result in, or otherwise render obvious, the invention recited independent claims 6 and 8 and the claims that depend therefrom.

## **VII. Conclusion**

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance and an early notification thereof is earnestly requested. The Examiner is invited to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,

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